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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/831,944

12/12/2001

Israel Sarussi

P-2040-US

9891

35650

7590

04/08/2003

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EXAMINER

WINAKUR, ERIC FRANK

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 04/08/2003

71

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/831,944

Applicant(s)

SARUSSI, ISRAEL

Examiner

Eric F Winakur

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-28 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-35 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-19, 21-23 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 11, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejections of claims 1 - 6, 10, 13 - 18, 21 - 23, and 26 - 28 under 35 U.S.C. 102(b) as being anticipated by Goodman et al., claims 1, 4, 13, 14, 22, 23, 27, and 28 under 35 U.S.C. 102(b) as being anticipated by Muz, claims 1 - 4, 7, 10, 12 - 16, 19, 27, and 28 under 35 U.S.C. 102(b) as being anticipated by Ogawa et al., and claims 1 - 9, 13 - 19, 21, 27, and 28 under 35 U.S.C. 102(e) as being anticipated by Rafert et al. are hereby maintained.

### ***Double Patenting***

3. Claims 11, 24, and 25 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 33 - 35. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

It is noted that Applicant has filed new claims 33 - 35 to present the subject matter of dependent claims 11, 24, and 25 in independent form, but has not canceled the dependent claims.

### ***Response to Arguments***

4. Applicant's arguments filed January 22, 2003 have been fully considered but they are not persuasive. Applicant contends that none of the references meet the claim

Art Unit: 3736

limitations, as amended. In particular, Applicant states that the prior art cited by the Examiner 'meet either expressly or inherently the limitation that "the adhering component fastens the performing component to the tissue so that the detector only receives rays which are transmitted through or reflected from the tissue".' It appears that Applicant intended to state that the prior art cited by the Examiner "does not meet...", as they conclude that the references do not anticipate either the amended independent claims or any of the dependent claims.

Contrary to Applicant's assertions, the references are considered to meet the claim limitations, at least for the following reasons. First, the claims merely set forth that the detector 'only receives rays which are transmitted through or reflected from the tissue'. This language does not exclude detection of surface reflections, even if Applicant's preferred embodiment only receives rays that are reflected from within the tissue. Further, even if Applicant were to amend the claims in this manner, the structures disclosed in the references would meet this more narrowly recited limitation, as the structures of Rafert and Ogawa include protrusions designed specifically to enhance contact between the skin and the sensor, and the sensors of Muz and Goodman et al. are designed to avoid formation of internal reflections. Thus, the documents themselves provide the teachings of each and every limitation recited in the claims.

***Allowable Subject Matter***

5. Claims 33 - 35 are allowed.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F Winakur whose telephone number is 703/308-3940. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

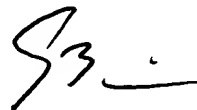
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 703/308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are 703/305-3590 for regular communications and 703/305-3590 for After Final communications.

Application/Control Number: 09/831,944

Page 5

Art Unit: 3736

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0858.

A handwritten signature in black ink, appearing to read 'S3' followed by a horizontal line and a small flourish.

Eric F Winakur  
Primary Examiner  
Art Unit 3736

April 1, 2003